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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
HANSULRICH REISACHER, ET AL.	: EXAMINER: HAILEY, P.
SERIAL NO: 10/501,343	:
FILED: JULY 26, 2004	: GROUP ART UNIT: 1755
FOR: PIGMENT PREPARATIONS	:

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal of the Final Rejection dated May 16, 2006 of Claims 1-12. A Notice of Appeal is **submitted herewith**.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is BASF Aktiengesellschaft having an address 67056 Ludwigshafen, Germany.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and the assignee are aware of no appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal, except for the appeal in copending Application No. 10/515,345.

III. STATUS OF THE CLAIMS

Claims 1-12, all the claims in the application, stand rejected and are herein appealed.

IV. STATUS OF THE AMENDMENTS

An Amendment under 37 CFR 1.116 was timely filed on June 14, 2006. In an Advisory Action entered July 19, 2006, the Examiner indicated that upon the filing of an appeal, the amendment will be entered. The attached Claims Appendix reflects Claims 1-12 as amended by the above-referenced Amendment under 37 CFR 1.116.

The Advisory Action also indicates, in effect, that the rejection under 35 U.S.C. §112, second paragraph, has been withdrawn.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent Claim 1 is drawn to a solid pigment preparation including as essential constituents

(A) from 60 to < 90% by weight of at least one pigment,

(B) from 10 to < 40% by weight of at least one nonionic surface-active additive based on polyethers, and

(C) from 0.1 to 10% by weight of at least one anionic surface-active additive based on sulfonates, sulfates, phosphonates or phosphates,

the sum total of the weight percentages not exceeding 100% by weight.

See the specification at page 2, lines 21-34.

VI. GROUNDS OF REJECTION

Ground (A)

Claims 1-5, 7-10 and 12 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. 6,110,266 (Gonzalez-Blanco et al).

Ground (B)

Claims 6 and 11 stand rejected under 35 U.S.C. §103(a) as unpatentable over Gonzalez-Blanco et al in view of U.S. 6,646,023 (Nyssen).

Ground (C)

Claims 1-12 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting over Claims 1-20 of copending application no. 10/515,345.

VII. ARGUMENT

Ground (A)

Claims 1-5, 7-10 and 12 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. 6,110,266 Gonzalez-Blanco et al. That rejection is untenable and should not be sustained.

The present invention, as recited in Claim 1, is drawn to a **solid** composition. Indeed, as described in the specification beginning at page 1, line 25, liquid-based pigment formulations are known in the art but have been problematical, for reasons described.

Applicants further describe that simply drying the liquid formulations does not provide solid pigment preparations having comparable application properties.

Gonzalez-Blanco et al, on the other hand, is drawn to a composition that is necessarily liquid, i.e., a water-containing pigment preparation for an ink-jet ink. The Examiner previously found that the use of the present term "including" in the present claims leaves them open to the inclusion of water, such as disclosed in Gonzalez-Blanco et al. Applicants replied that while the Examiner is correct that the present term "including" leaves the claims open to unspecified materials, including water, the claims exclude such materials which would change the claimed composition from something other than a solid composition. Thus, while the presently-claimed composition may contain water, it may not contain sufficient water to render the overall composition liquid. Moreover, even if Gonzalez-Blanco et al did disclose solid compositions, while Gonzalez-Blanco et al discloses the use of "at least one" dispersant, wherein the dispersants may be non-ionic, anionic, cationic, **or** amphoteric compounds (column 2, lines 53-54; emphasis added), it would appear that Gonzalez-Blanco et al does contemplate more than one nonionic dispersant, or more than one anionic dispersant, etc., but not mixtures of different types of dispersants. Nevertheless, even if Gonzalez-Blanco et al does contemplate such mixtures of different dispersants, there is no disclosure or suggestion therein to use particular combinations of nonionic and anionic dispersants, let alone those recited in the present claims and within the percentage ranges of the present claims.

In the Advisory Action, the Examiner finds that Gonzalez-Blanco et al is not drawn to an ink-jet ink, but is rather drawn to a pigment preparation used in said ink, relying on the disclosure at column 8, lines 8-22 and column 10, lines 24-25.

In reply, the Examiner is technically correct in that Gonzalez-Blanco et al discloses pigment preparations in inks for ink-jet printing, but there is still no indication or suggestion

in Gonzalez-Blanco et al that their pigment preparations may be solid. Indeed, in the passage cited by the Examiner at column 8, lines 8-22, water is present in a minimum amount of 10%, and preferably 30%, by weight, while an organic solvent may also be present. The description of the preparation of the pigment preparations provides further evidence that the preparations are in liquid form, such as reference to the pigment preparation in terms of suspension or dispersion, as in "pigment concentration of the suspension" (column 9, line 8), "desired fine dispersion of the particles" (column 9, lines 13-14), etc.

Regarding whether Gonzalez-Blanco et al discloses or suggests combinations of different classes of dispersants, the Examiner finds that Gonzalez-Blanco et al "does not exclude the contemplation of one (or more) of each dispersant, i.e., one nonionic dispersant, and one anionic dispersant."

In reply, the question is not what Gonzalez-Blanco et al contemplate, but what they disclose or suggest to persons skilled in the art. Gonzalez-Blanco et al disclose, for example, anionic and cationic dispersants, yet persons skilled in the art would not combine such antagonistic dispersants for well-known reasons.

For all the above reasons, it is respectfully requested that this rejection be REVERSED.

Ground (B)

Claims 6 and 11 stand rejected under 35 U.S.C. §103(a) as unpatentable over Gonzalez-Blanco et al in view of U.S. 6,646,023 (Nyssen). That rejection is untenable and should not be sustained.

Nyssen does not remedy the above-discussed deficiencies of Gonzalez-Blanco et al. Nyssen is drawn to solid pigment preparations for coloring seed and seed-dressing materials. Without the present disclosure as a guide, it is not clear why one skilled in the art would

combine Gonzalez-Blanco et al and Nyssen, but even if combined, the result would not be the presently-claimed invention. It is not clear why a person concerned with a problem in the ink-jet ink art would seek a solution in the colored seed or seed-dressing art, or vice versa; nor is it clear why one skilled in the art would combine disclosure of solid pigment compositions with liquid pigment compositions. Moreover, even if the liquid pigment preparation of Gonzalez-Blanco et al were modified as suggested by the Examiner, the result would still be a liquid composition. Finally, even if the pigment preparation of Gonzalez-Blanco et al were in solid form, there is no disclosure or suggestion in Gonzalez-Blanco et al to granulate such a solid.

For all the above reasons, it is respectfully requested that this rejection be REVERSED.

Ground (C)

Claims 1-12 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting over Claims 1-20 of copending application no. 10/515,345. That provisional rejection is untenable and should not be sustained.

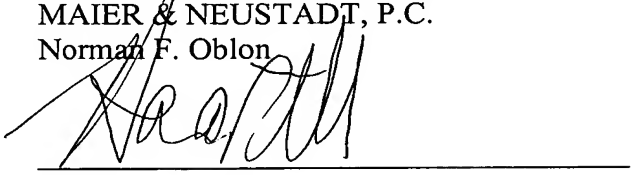
The claims of the copending application neither disclose nor suggest the subject matter of the present claims, particularly the requirement of a maximum of 10% by weight for the anionic surface-active agent component. Accordingly, it is respectfully requested that this provisional rejection be REVERSED.

VIII. CONCLUSION

For the above reasons, it is respectfully requested that all the rejections still pending in the Final Office Action be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



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CLAIMS APPENDIX

1: A solid pigment preparation including as essential constituents

(A) from 60 to < 90% by weight of at least one pigment,

(B) from 10 to < 40% by weight of at least one nonionic surface-active additive based on polyethers, and

(C) from 0.1 to 10% by weight of at least one anionic surface-active additive based on sulfonates, sulfates, phosphonates or phosphates,

the sum total of the weight percentages not exceeding 100% by weight.

2: Pigment preparation as claimed in claim 1, wherein component (B) comprises alkylene oxide block copolymers.

3: Pigment preparation as claimed in claim 1, wherein component (B) comprises alkylene oxide adducts with at least bifunctional amines or alcohols.

4: Pigment preparation as claimed in claim 1, wherein component (C) comprises arylsulfonates and/or ether sulfates.

5: Pigment preparation as claimed in claim 1, wherein component (C) comprises ether phosphates.

6: Pigment preparation as claimed in claim 1, in the form of granules having an average particle size from 50 to 5000 μm and a BET surface area of $\leq$15 m^2/g.

7: A process for producing a pigment preparation as claimed in claim 1, which comprises wet-comminuting the pigment (A) in aqueous suspension in the presence of some or all of additive (B) and in the presence or absence of additive (C), subsequently adding additive (C) if the wet-comminuting was carried out in its absence, and then drying the suspension, if necessary after the rest of additive (B) has been added.

8: A process for pigmenting macromolecular organic or inorganic materials, which comprises incorporating a pigment preparation as claimed in claim 1 into these materials by stirring or shaking.

9: A process as claimed in claim 8, wherein said macromolecular organic or inorganic materials are pigmenting coatings, paints, inks, or finish systems, where a liquid phase comprises water, organic solvent or mixtures of water and organic solvent.

10: A process for pigmenting macromolecular organic or inorganic materials using color-mixing systems, which comprises incorporating a pigment preparation as claimed in claim 1 as mixing components.

11: Pigment preparation as claimed in claim 6, wherein the average particle size is from 100 to 1,000 μm and the BET surface area is $\leq$10 m^2/g.

12: Pigment preparation as claimed in claim 1, wherein component (A) is present in an amount of from 60 to 85% by weight, component (B) is present in an amount of from 10 to 30% by weight, and component (C) is present in an amount of 0.2 to 10% by weight.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.